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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/981,248

10/16/2001

Mark A. Hoffman

CRNC.83071

6008

46169

7590

02/28/2006

SHOOK, HARDY & BACON L.L.P.
Intellectual Property Department
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KANSAS CITY, MO 64108-2613

EXAMINER

MORAN, MARJORIE A

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/981,248	Applicant(s) HOFFMAN ET AL.	
	Examiner Marjorie A. Moran	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-30, 55-60 and 85-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30, 55-60, and 85-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/05 has been entered.

Claims 25-30, 55-60, and 85-91 are pending. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. All objections and rejections set forth in the final office action are maintained for the reasons set forth below.

Claim Objections

Applicant is advised that should claim 26 be found allowable, new claim 91 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Amended claim 26 and amended claim 91 are still identical in scope, and applicant has not presented any arguments in the response filed 11/28/05 to overcome this objection, therefore it is maintained.

Claim Rejections - 35 USC § 103

Applicant's arguments filed 11/28/05 have been fully considered but they are not persuasive. The arguments are addressed below as they pertain to specific rejections.

Claims 25-27, 29-30, 55-57, 59-60, 85-87 and 89-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over ICHIKAWA (Internal Medicine (July, 2000) vol. 39, no. 7, pp. 523-524) in view of EVANS et al. (IDS ref: Science (Oct. 1999) vol. 286, pp. 487-491) and REINHOFF et al. (US 2002/0049772 A1, filed 5/26/2000).

In response to the argument that none of ICHIKAWA, EVANS, or REINHOFF teach a step of querying a computerized table listing polymorphism values and atypical clinical events associated with those values, it is noted that contrary to applicant's arguments, EVANS does, in fact, teach a computerized table of atypical clinical events associated with polymorphism values (see p. 489, Table I and the legend that states "A comprehensive listing is available at www.sciencemag.org/feature/data/104449.shl"). It is noted that the table of EVANS contains many of the genes, polymorphic sites, and atypical events disclosed by the instant specification in Table 2 on page 16. Further, REINHOFF teaches populating a computerized database with genotypic and phenotypic data (para 38) and teaches that polymorphic profiles of individuals may be associated

with response to drugs in a computerized method (para 57), and specifically teaches analysis of such data in a computerized database (para 58), thus teaching a step of “querying” a computerized listing comprising polymorphic data and atypical clinical events associated with the polymorphic data. A step of accessing the (computerized) list or table of EVANS in a computer-implemented method, as taught by REINHOFF, is made obvious by the combination of references for the reasons previously set forth and reiterated below.

Reiterated from the office actions of 2/17/05 and 9/8/05:

“It would have been obvious to one of ordinary skill in the art at the time of invention to have computerized, or automated, the genetic screening method of ICHIKAWA, as taught by REINHOFF, and to have accessed a list of treatment/drug options, as taught by EVANS, in the automated method of ICHIKAWA and REINHOFF, where the motivation would have been to facilitate use of the method to identify patients appropriate for treatment when a choice is to be made among various options, as taught by REINHOFF (paragraph 59).”

Thus, the examiner maintains that both EVANS and REINHOFF do, in fact, teach computerized tables comprising polymorphism values and atypical clinical events associated with those values, and that REINHOFF teaches accessing or querying such a table, and maintains that the combination of references makes obvious and motivates accessing such a table in a method (and apparatus and computer-readable medium for running the method) for processing hereditary (genetic) data, such as taught by

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ICHIKAWA. For these reasons and those previously set forth, the rejection is maintained.

Claims 28, 58, and 88 are again rejected under 35 U.S.C. 103(a) as being unpatentable over ICHIKAWA (Internal Medicine (July, 2000) vol. 39, no. 7, pp. 523-524) in view of EVANS et al. (IDS ref: Science (Oct. 1999) vol. 286, pp. 487-491) and REINHOFF et al. (US 2002/0049772 A1, filed 5/26/2000), as applied to claims 25-27, 29-30, 55-57, 59-60, 85-87 and 89-91 above, and further in view of FEY et al. (US Pub. 20020038227, filed 2/26/01).

In response to the argument that FEY does not teach a step of querying a computerized table listing polymorphism values and atypical clinical events, it is noted that EVANS and REINHOFF teach such a table and step, as set forth above. In the combination of references set forth in the instant rejection, FEY is relied upon in the rejection for his teaching of a comprehensive healthcare system/database, not for a teaching of computerized steps, thus applicant's arguments are not persuasive.

As the examiner maintains that ICHIKAWA, EVANS and REINHOFF make obvious the limitations of claims 25-27, 29-30, 55-57, 59-60, 85-87 and 89-91, as set forth above, she also maintains that ICHIKAWA, EVANS, REINHOFF and FEY make obvious claims 28, 58, and 88 for the reasons set forth above and previously set forth.

Conclusion

No claims are allowed.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon,Wed: 7-1:30; Tue,Thur: 7:30-6; Fri 7-3:30 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran
Primary Examiner
Art Unit 1631

Marjorie A. Moran
2/16/06